



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,101	04/08/2004	Agostino Tucciarone	AT-11	1706
21394	7590	03/20/2006	EXAMINER	
ARTHROCARE CORPORATION 680 VAQUEROS AVENUE SUNNYVALE, CA 94085-3523			HOFFMAN, MARY C	
		ART UNIT	PAPER NUMBER	
		3733		

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/822,101	TUCCIARONE ET AL.
	Examiner Mary Hoffman	Art Unit 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 February 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 4/8/02 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948).
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Priority***

Regarding the claims for priority, the transmittal letter filed on 4/08/2004 states that current application 10/822101 is a continuation of prior application PCT/GB03/01606. Also filed on date 4/08/2004, the application data sheet states that applicant intends to claim foreign priority under 35 USC 119 to prior application PCT/GB03/01606. In the supplementary application data sheet filed 6/07/2004, applicant restates his intention to claim foreign priority to prior application PCT/GB03/01606, also including a claim to foreign priority to prior British patent application GB 0208667.6. Applicant has affirmed in the response filed on 2/16/2006 that the application claims foreign priority under 35 USC 119 to prior application PCT/GB03/01606 and prior British patent application GB 0208667.6, as listed on the supplementary application data sheet filed 6/07/2004.

Therefore, the current application will be treated as claiming foreign priority to prior application PCT/GB03/01606 and prior British patent application GB 0208667.6 as stated on the supplementary application data sheet filed 6/07/2004, and it will not be treated a continuation from PCT/GB03/01606 as stated on the transmittal letter filed on 4/08/2004. It is also noted that applicant has not filed certified copies of the prior applications as required by 35 U.S.C. 119(b). Furthermore, a claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on British application GB 0208667.6, since the United States application was filed more than twelve months thereafter.

***Oath/Declaration***

No supplemental oath/declaration is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, the phrase "such as" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Whelan (U.S. Patent No. 5,918,604).

Whelan discloses a method of ACL graft ligament fixation comprising the steps of forming a femoral tunnel (FIG. 12, ref. #56); forming a transverse tunnel intersecting the femoral tunnel (FIG. 12, ref. #71); locating a graft loop in the femoral tunnel in such a manner that an open face of the loop faces an intersection where the femoral tunnel intersects the transverse tunnel, and wherein the locating comprises pulling on a loop, functionally equivalent to sutures in this method, (FIG. 14, ref. #34) holding the graft loop to locate the graft loop (FIG. 14, ref. #76), passing at least a part of a head section of a transverse suspension device through the graft loop via the transverse tunnel until the head contacts an opposite wall of the femoral tunnel (see FIG. 15). After location of the graft loop in the femoral tunnel, a guide wire (ref. #30, 32) is advanced thereunder from the transverse tunnel until the head contacts an opposite wall of the femoral tunnel. The suspension device is passed along the guide wire after the guide wire is advanced under the graft loop. (col. 6, lines 25-26). The head of the device is advanced as far as a distal head of a recess formed in the opposite wall of the femoral tunnel. The graft is urged against the opposite wall as the head is advanced into the recess. The method further comprises advancing a passing pin (ref. #12) having the loop attached thereto through the femoral tunnel and through a passing pin tunnel prior to the locating step.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Wolf et al. (U.S. Patent No. 5,601,562).

Wolf et al. disclose a method of ACL graft ligament fixation comprising the steps of forming a femoral tunnel; forming a transverse tunnel intersecting the femoral tunnel; locating a graft loop in the femoral tunnel in such a manner that an open face of the loop faces an intersection; and passing at least a part of a head section of a transverse suspension device (ref. # 4) through the graft loop via the transverse tunnel until the head contacts an opposite wall of the femoral tunnel (see FIG. 1). The device comprises an abutment surface located proximal the head section capable of urging the graft against the opposite wall (ref. #40).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whelan (U.S. Patent No. 5,918,604).

Whelan discloses the claimed invention except for using a suitable viewing device such as an arthroscope.

Howell et al. disclose an arthroscope in order to visualize the femoral tunnel (col. 6, lines 43-46).

It would have been obvious to one of ordinary skill in the art to perform the method of Whelan with an arthroscope in view of Howell et al. in order to visualize the femoral tunnel.

***Response to Arguments***

Applicant's arguments with respect to claims 15-18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER